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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/847,113	05/01/2001	Chunlin Tao	A-69306-1/RFT/RMS/RMK	5406

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EXAMINER

MAUPIN, CHRISTINE L

ART UNIT PAPER NUMBER

1637

DATE MAILED: 10/02/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-11 are drawn to self-assembly monolayer compositions, classified in class 536, subclass 101.
- II. Claims 12-25 are drawn to methods of fixing a monolayer on a metallic surface, classified in class 435, subclass 168.
- III. Claims 26-44 are drawn to methods of detecting analytes, classified in class 435, subclass 40.51.

The invention of group I, and the inventions of group II and group III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the products of the self-assembly monolayer compositions may be used to measure isothermal constants with out the methods of group II and group III. The products of group one may also be sure in a solution phase in vacuum for surface properties with out the methods of group II or group III.

The invention of group II and the invention of group III are unrelated. Inventions are unrelated if it can be shown that they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions the methods of group II do not require the same procedures and

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have different modes of operation and have the different out final outcomes. Group III requires the binding of an analyte, which is not required for the inventions of group I or group II. Whereas, group II requires the step of contacting a surface with a biological surface which is not required for the inventions of group I, and III.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper. Therefore, because these inventions are distinct for the reasons given above and the search required for one group is not required for another group, restriction for examination purposes as indicated is proper.

This application contains claims directed to the following patentably distinct species of the claimed invention: MFS, AG, A, insulator, R3-R5, capture binding ligand, linker, nucleic acid, protein, EMT.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1, 12, and 26 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include

all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

A telephone call was made to Robin Silvia on September 17th, 2002 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement is traversed (37 CFR 1.143).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christine L. Maupin; whose telephone number is (703) 308-3617 and fax number is (703) 746-7641.

The examiner is normally in the office between the hours of 9:30 a.m. and 5:30 p.m., and telephone calls either in the morning or the mid-afternoon are most likely to find the examiner in the office.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion, can be reached on (703) 308-1119.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1234.

Papers related to this application may be submitted to Technology Center 1600 by facsimile transmission via the U.S.P.T.O. Fax Center located in Crystal Mall 1. The CM1 Fax Center numbers for Technology Center 1600 are either (703) 308-4242 or (703) 308-2724. Please note that the faxing of such papers must conform with the Notice to Comply published in the Official Gazette, 1096 OG 30 (November 15, 1989).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1123.

September 26, 2002


JEFFREY FREDMAN
PRIMARY EXAMINER

Christine L. Maupin
Examiner
Art Unit 1637